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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,289

01/23/2004

James D. Raymond

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11/17/2006

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EXAMINER

JUNKER, JONATHAN T

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/762,289	Applicant(s) RAYMOND, JAMES D.	
	Examiner Jonathan T. Junker	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 5-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/23/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species:

- I) Generally circular shaped termite deterrent
- II) Generally square shaped termite deterrent

The species are independent or distinct because the two embodiments are structurally different and would require two independent searches.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

During a telephone conversation with Dolph Torrence on 08 November 2006 a provisional election was made with traverse to prosecute the invention of a generally circular shaped termite deterrent, claims 1-4. Affirmation of this election must be made by applicant in replying to this Office action. Claim 5-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1-4 are pending in the current application and claims 5-8 are withdrawn from consideration.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the calking, asphalt, rounded edge (a chamfered edge is shown) and an outward angled sidewall must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The term "smooth" in claim 4 is a relative term which renders the claim indefinite.

The term "smooth" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

In this case, the term "smooth" has not defined what characteristics of the surface make it smooth. The term "smooth" can either relate to the geometry of the apparatus or the surface finish.

Claim Objections

Regarding claim 1, the language between the preamble and portions of the body of the claim are inconsistent. For example, the preamble of claim 1 sets for the subcombination " termite deterrent and protective cap"; however, lines 8-9 of the claim

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recites "[the protective cap] in contact with the outer walls of the generally circular circumference pier or post" which sets forth a positive relationship between the protective cap and the pier or post and thus appears to claim a combination.

Applicant should note that a claim with a preamble citing a subcombination is considered as being drawn to the subcombination alone. Subsequent language which sets forth a positive relationship between the subcombination and other structure should be changed to "capable of being positioned adjacent" or similar language.

However, if Applicant intended to claim the combination, the language of the preamble should be changed to indicate the combination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wannamaker, US Patent 1,637,627 in view of White, US Patent 4,339,916.

Wannamaker discloses a circular disk with a topside (5 fig 2), a periphery and sidewalls with an inside surface that extend downward from the periphery of the circular disk (6 fig 3), said circular disk and sidewalls placed on top of the generally circular circumference pier or post being protected (P fig 1), with the inside surface of the sidewalls not being in contact with the outer walls of the generally circular circumference pier or post (A fig 1),

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while said termite deterrent and protective cap are secured to the top of the generally circular circumference pier or post being protected (fig 1), said sidewalls at a slightly outward angle to a perpendicular of the periphery of the circular disk for easy stacking and storage(6 fig 2); and said sidewalls and circular disk come together to form a rounded edge on the outer surface of the termite deterrent and protective cap (the surfaces 5 and 6 fig 2 meet at a corner and create a round edge). Wannamaker does not disclose the circular disk having a scored inner circular center, however, White disclose a panel that has a scored surface for being able to remove a circular center. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the circular disk of Wannamaker and the scored circles of White for the removal of the circular center so as to allow the drift pin D (fig 1) of Wannamaker to pass through the circular disk without deforming and compromising the exterior of the disk.

The phrase "that can be removed to accommodate a thread rod from the generally circular circumference pier or post that would extend through the plane of the inner circular center" is a recitation of intended use, which does not further limit the structural features of the claimed invention. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed limitations.

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Claim 2 rejected under 35 U.S.C. 103(a) as being unpatentable over Wannamaker in view of White as applied to claim 1 above, and further in view of Rasmussen et al. US Patent 5,934,035. Wannamaker in view of White disclose the protective cap according to claim 1 however do not disclose the cap being secured to the post using caulking. Rasmussen et al. discloses caulking (30 fig 2) disposed in between a cap (44 fig 2) and a pillar (12 fig 2). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use caulk to seal a cap to a pillar to prevent the ingress of moisture and insects.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wannamaker in view of White. Wannamaker in view of White disclose the protective cap according to claim 1, Wannamaker further discloses the protective cap being secured to the post with asphalt (lines 77-84). It is noted that asphalt is naturally occurring pitch, and is called mineral tar and mineral pitch.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wannamaker in view of White as applied to claim 1 above, and further in view of Watts, US Patent 4,161,090. Wannamaker in view of White disclose the protective cap according to claim 1, but do not disclose the protective cap being made of polyethylene. Watts discloses a cap made of polyethylene. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to make a protective cap

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out of polyethylene so that the cap would not rust or deteriorate due to prolonged exposure to the elements.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan T. Junker whose telephone number is (571)272-4020. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on (571) 272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JTJ

11/9/2006



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